

REMARKS

Claims 14, 15 and 22-25 are pending in this application. None have been allowed.

At page 2 of the Action the Examiner summarized the three Restriction Groups:

Group I: Method claims 1-13,

Group II: Compound claims 14-15,

Group III: Composition Claims 16-18.

In the material bridging pages 2 and 3 of the Action, the Examiner made applicants election of Group II, final, and stated that "Applicant's elected without traverse, 4-methyl-17 β -[(4-trifluoromethylphenyl)acetamido-4-aza-5 α -androst-1-ene-3-one, where: R¹ is methyl, R² is trifluoromethylphenyl, R³ is methyl, R⁴ is hydrogen, R⁵ is hydrogen, X is -C(O)-, a is a double bond, and b is a single bond."

Accordingly, applicants have cancelled claims the claims of Groups I and III. Applicants respectfully submit that once compounds within claims 14 and 15 are allowed, Applicants are entitled to re-introduce claims of Group III, to the extent that they are direct to compositions comprising the allowed compounds.

Applicants have also added a claim 22, in order to further advance the prosecution of this case. The new claim mirrors claim 14, with the exception "a" is a double bond and "b" is a single bond. Applicants have also added species claims 23-25. Support for these species claims is found in the original species claim 15.

At the middle of page 3 of the Action, the Examiner has rejected claims 14 and 15 under 35 USC 102(b) as being anticipated by Witzel (US 5,639,741). The Examiner made no rejections under 35 USC 103.

The Examiner states: "Witzel et al. teaches a compound (compound 12 of claim 15 of the instant application) 4-methyl-17 β -(2-fluorobenzamido)-4-aza-5 α -androst-1-ene-3-one (col. 18, line 9-10) and this addresses claims 14 and 15. The reference further teaches the following compounds: 17-(2,6-Difluorobenzamido)-4-methyl-5 α -4azaandrost-3-one (col. 19, lines 1-2), 17-(2,3-Difluorobenzamido)-4,7-dimethyl-5 α -4-azaandrost-3-one

(col. 19, lines 37-38), 4-Methyl-17-(3-fluoro-2-methylbenzamido)-5.alpha.-4-azaandrost-4-one and 4-methyl-17β-(propamido)-4-aza-5α-androst-1-ene-3-one"

Applicants respectfully submit that the Examiner's analysis is not correct. In particular:

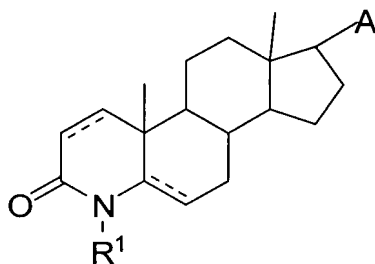
The Compound of Witzel at col. 18, line 9-10, is not "4-methyl-17β-(2-fluorobenzamido)-4-aza-5α-androst-1-ene-3-one" The Witzel compound (4-methyl-17β-(2-fluorobenzamido)-4-aza-5α-androst-1-ene-3-one) is missing the important double bond.

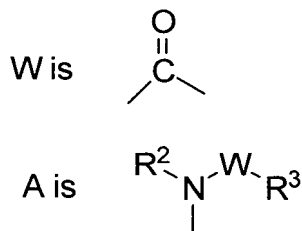
The Compound of Witzel at col. 19, line 1-2, "17-(2,6-Difluorobenzamido)-4-methyl-5-.alpha.-4azaandrost-3-one " is also missing the important double bond.

The Compound of Witzel at col. 19, line 37-38, "17-(2,3-Difluorobenzamido)-4,7-dimethyl-5-.alpha.-4-azaandrost-3-one" is also missing the important double bond.

The Compound of Witzel "4-Methyl-17-(3-fluoro-2-methylbenzamido)-5.alpha.-4-azaandrost-4-one "is also missing the important double bond. Applicants believe that this compound is found at col. 18, lines 46-47.

Finally, there is the issue of "4-methyl-17β-(propmido)-4-aza-5α-androst-1-ene-3-one". On May 17, the undersigned attorney called the Examiner because he was unable to find this compound in the reference. After review her file, the Examiner called back and explained that the compound in question was intended to be "4-methyl-17β-(propionmido)-4-aza-5α-androst-1-ene-3-one" (See underline). Moreover, in the Examiner's analysis the Witzel reference does not disclose this compound as a species. Rather, the reference only discloses the compound generically in column 5:





R^2 is hydrogen and R^3 is isopropyl.

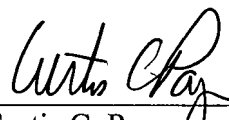
Applicants respectfully traverse. As explained above none of the species identified by column and line number by the Examiner anticipates a species of the instant application. The final compound mentioned by the Examiner is not in Witzel at all as a species. Moreover, the analysis of the generic disclosure is also incorrect. In that regard Applicants direct the Examiner's attention to column 5, lines 46-47 which read: "except when R^2 equals H, there is a 5 α H and W equals C(O), R^3 can not be C1-12alkyl". Thus, Witzel does not allow R^3 to be isopropyl as proposed by the Examiner.

Given that the only rejection is the above mentioned 102 rejection, applicants have traversed.

Having addressed all of the outstanding objections and rejections, applicants respectfully submit that the application is in condition for allowance and passage thereto is earnestly requested. For completeness, applicants observe that should the Examiner find and make a new rejection, the rejection cannot be a final rejection.

The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the application.

Respectfully submitted,

By 
Curtis C. Panzer
Reg. No. 33,752
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-3199

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